

This Opinion is Not a
Precedent of the TTAB

Hearing: March 18, 2021

Mailed: May 19, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re L-Nutra, Inc.

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Serial No. 88171365

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Thomas J. Speiss, III of Buchalter P.C. for L-Nutra, Inc.

Jillian R. Cantor, Trademark Examining Attorney, Law Office 117,
Hellen M. Bryan-Johnson, Managing Attorney.

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Before Zervas, Heasley, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

L-Nutra, Inc. (“Applicant”) seeks registration on the Principal Register of the proposed standard character mark FASTING BAR for goods ultimately identified as “Nutritionally balanced prepared meals for medical use consisting primarily of grains, nuts and vegetables; nutritional meal replacement snacks adapted for medical use,” in International Class 5.¹

¹ Application Serial No. 88171365 was filed on October 26, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Examining Attorney has refused registration of Applicant's proposed mark on the ground that it is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs,² and counsel for Applicant and the Examining Attorney appeared at a video hearing before the panel on March 18, 2021. We affirm the refusal to register.

I. Prosecution and Procedural History, and Record on Appeal³

Applicant originally sought registration of its proposed mark for “Nutritionally balanced prepared meals for medical use consisting primarily of grains, nuts and vegetables; nutritional meal replacement drinks, soups and snacks adapted for medical use; herbal teas for medical treatments; dietary supplements; food supplements; nutritional supplements; vitamin and mineral supplements; plant-based supplements containing algal oil, vegetable powders, vitamins and minerals.”⁴

² Citations in this opinion to the briefs and other docket entries on appeal, other than the request for reconsideration and its denial, refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) where the cited materials appear. Applicant's initial appeal brief appears at 7 TTABVUE and its supplemental brief, filed after the remand discussed below, appears at 17 TTABVUE. The Examining Attorney's brief appears at 19 TTABVUE.

³ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the USPTO's Trademark Status & Document Retrieval (“TSDR”) database.

⁴ October 26, 2018 Application at TSDR 1.

The Examining Attorney issued a first Office Action refusing registration under Section 2(e)(1), making of record dictionary definitions of the words “fast” and “bar,”⁵ and third-party webpages regarding the use of the goods identified in the application, including supplement bars, in various diet plans, including reduced-calorie, intermittent fasting, or fasting mimicking diets.⁶ She also issued an information request under Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b), in which she sought, inter alia, screenshots from Applicant’s website and other materials regarding the intended use of the proposed mark, and responses to four questions: “(a) Do the goods include a fasting period? (b) Are the goods used as part of a fasting diet? (c) Are the goods used as part of a restricted calorie diet? (d) Do the goods include a bar of any kind?”⁷

Applicant’s response to the Office Action argued against the mere descriptiveness refusal and provided extensive background information regarding Applicant, its founder, Dr. Valter Longo, a professor of gerontology and biological sciences at the University of Southern California, and its various trademarks, including the proposed mark, as well as specific responses to the first of the four questions in the information request.

Applicant stated that it is a company that

⁵ December 10, 2018 Office Action at TSDR 2-11, 49-53.

⁶ *Id.* at TSDR 12-48, 54-80. As discussed below, intermittent fasting diets and fasting mimicking diets involve the consumption of a normal diet during certain days or other periods and the consumption of a reduced number of calories or the avoidance of certain foods during other times.

⁷ *Id.* at TSDR 1.

researches, produces and provides nutrition related products and services, specifically nutria-technologies and fasting mimicking diets (FMDs), which serve to prevent, delay, or treat chronic diseases or to manage and maintain body weight, healthy levels of cholesterol, blood pressure, etc. It further developed a different product category, meal replacement products (such as FAST BAR), which are based on the same medical research. The FASTING BAR products are contemplated to be part of the meal replacement category.⁸

Applicant further stated that its “FASTING BAR products are contemplated to resemble its FAST BAR meal replacement products,” which Applicant stated were the subject of several co-pending applications.⁹

Applicant answered the Examining Attorney’s specific questions as follows:

“a) Do the FASTING BAR goods include a fasting period?

No. Like with the FAST BAR products, the FASTING BAR products can be eaten as a meal replacement, or as a healthy snack.

b) Are the FASTING BAR goods used as part of a fasting diet?

No. Like with the FAST BAR products, the FASTING BAR products can be eaten as a meal replacement, or as a healthy snack.

c) Are the FASTING BAR goods used as part of a restricted calorie diet?

No. Like with the FAST BAR products, the FASTING BAR products can be eaten as a meal replacement, or as a healthy snack.

d) Do the FASTING BAR goods include a bar of any kind?

⁸ June 10, 2019 Response to Office Action at TSDR 2.

⁹ *Id.* at TSDR 3.

Yes, some of the covered goods will come in bar or block form.”¹⁰

Applicant also made of record what it described as its specimen of use on Application Serial No. 87635643 to register FAST BAR.

The Examining Attorney issued a final Office Action on the mere descriptiveness refusal, making of record additional third-party websites discussing the use of the goods identified in the application in connection with reduced-calorie or fasting diets.¹¹

Applicant then appealed and requested reconsideration,¹² which was denied.¹³ After the appeal was resumed, 6 TTABVUE, Applicant filed its initial appeal brief, 7 TTABVUE, in which it purported to amend the identification of goods to read “[n]utritionally balanced prepared meals for medical use consisting primarily of grains, nuts and vegetables; nutritional meal replacement snacks adapted for medical use.” *Id.* at 5.¹⁴ Applicant also attached to its appeal brief the results of a Google search for the term “fasting bar.” *Id.* at 10-14.

The Examining Attorney then sought a remand of the application for two reasons:

¹⁰ *Id.* at TSDR 5-6.

¹¹ June 28, 2019 Final Office Action at TSDR 2-33.

¹² December 27, 2019 Request for Reconsideration at TSDR 1.

¹³ January 13, 2020 Denial of Request for Reconsideration at TSDR 1.

¹⁴ “Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding.” *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *2 (TTAB 2020) (discussing hierarchy of preferred means for amending an application). “As a best practice, an applicant seeking to obviate a refusal by proposing an amendment to an application should propose the amendment as early as possible during prosecution.” *Id.*, at *1-2.

First, Applicant amended the identification to delete a significant amount of wording, and specifically the wording for which the evidence in the record was strongest in order to avoid the refusal. Second, Applicant improperly added evidence to the record to bolster its argument based on the amended identification, and not allowing remand would provide Applicant with an unfair advantage of being able to change the focal point of the argument as this is the first time the examining attorney has had the opportunity to review the evidence and will be unable to counter it on appeal.

10 TTABVUE 3. The Board granted the Examining Attorney's request, 14 TTABVUE 1, and the application was remanded to her for submission of the new evidence.

The Examining Attorney then made of record additional third-party webpages regarding the use of nutrition bars as meal replacements in fasting diets,¹⁵ as well as a review of Applicant's Fast Bar product,¹⁶ and additional webpages regarding intermittent fasting diets.¹⁷

The appeal then resumed, and Applicant was granted leave to file a supplemental brief, 16 TTABVUE 1, which it did. 17 TTABVUE. The Examining Attorney then filed her brief. 19 TTABVUE.

II. Mere Descriptiveness Refusal

A. Applicable Law

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with

¹⁵ June 11, 2020 Final Office Action at TSDR 2-14.

¹⁶ *Id.* at TSDR 15-29.

¹⁷ *Id.* at TSDR 29-65.

the goods of the applicant is merely descriptive . . . of them,” unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).¹⁸ “A mark is ‘merely descriptive’ within the meaning of Section 2(e)(1) ‘if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.’” *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *3 (TTAB 2019) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)).¹⁹ “A mark need not recite each feature of the relevant goods or services in detail to be descriptive, it need only describe a single feature or attribute.” *Omniome*, 2020 USPQ2d 3222, at *3 (quoting *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012)).

The descriptiveness of a mark in an intent-to-use application must be determined by the goods or services identified in the application. *See Octocom Sys. Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1990); *In re Vehicle Identification Network, Inc.*, 32 USPQ2d 1542, 1544 (TTAB 1994). Whether a mark is merely descriptive is “evaluated ‘in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use,’” *Chamber of Commerce*, 102 USPQ2d at

¹⁸ Applicant does not claim that its proposed mark has acquired distinctiveness.

¹⁹ The proposed mark need not describe a feature or attribute of all goods in the application for the refusal to be affirmed. “If a mark is descriptive of any of the [goods] in a class for which registration is sought, it is proper to refuse registration as to the entire class.” *Chamber of Commerce*, 102 USPQ2d at 1219. *See also In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 479, at *5 n.8. (TTAB 2021).

1219 (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)), and “not in the abstract or on the basis of guesswork.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). We ask “whether someone who knows what the goods and services are will understand the mark to convey information about them.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive rather than merely descriptive if it requires imagination, thought, and perception on the part of someone who knows what the goods are to reach a conclusion about their nature from the mark. *See, e.g., Fat Boys*, 118 USPQ2d at 1515.

Applicant’s proposed mark consists of two words, FASTING and BAR. We “must consider the *commercial impression* of a mark as a whole.” *Real Foods*, 128 USPQ2d at 1374 (quoting *DuoProSS*, 103 USPQ2d at 1757 (citation omitted)). “In considering [a] mark as a whole, [we] ‘may not dissect the mark into isolated elements,’ without ‘consider[ing] . . . the entire mark,’” *id.* (quoting *DuoProSS*, 103 USPQ2d at 1757), but we “may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *Id.* (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004)). Indeed, we are “required to examine the meaning of each component

individually, and then determine whether the mark as a whole is merely descriptive.” *DuoProSS*, 103 USPQ2d at 1758.

If the two words in the proposed mark are individually descriptive of the identified goods, we must then determine whether their combination “conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *Fat Boys*, 118 USPQ2d at 1515-16 (quoting *Oppedahl & Larson*, 71 USPQ2d at 1372). If each word instead “retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive.” *Id.* at 1516 (citing *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); *see also In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1953-55 (TTAB 2018).

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). “These sources may include [w]ebsites, publications and use ‘in labels, packages, or in advertising material directed to the goods.’” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *Abcor Dev.*, 200 USPQ at 218).

“It is the Examining Attorney’s burden to show, *prima facie*, that a mark is merely descriptive of an applicant’s goods or services.” *Fat Boys*, 118 USPQ2d at 1513 (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)). “If such a showing is made, the burden of rebuttal shifts to the applicant.” *Id.* (citing *In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003)). “The Board resolves

doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (citing *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994)).

B. Summary of Arguments

1. Applicant

Applicant argues that the proposed mark does not immediately convey information regarding the goods identified in the amended identification. 17 TTABVUE 5. Applicant claims that the word “fast” was defined by the Examining Attorney as “to eat sparingly or abstain from some foods,” *id.* at 6, and argues that “[u]nder the Examining Attorney’s definition of ‘abstaining from food,’ the Applicant would not be providing nutritionally balanced prepared meals for medical use and nutritional meal replacement snacks for medical use in connection with its Mark, but rather would be providing a diet without food.” *Id.* at 7. According to Applicant, this results in an oxymoron because “an individual cannot simultaneously fast and eat – it is one or the other,” *id.*, and the “Examining Attorney believes that the Mark means to *abstain* from food, yet the Applicant is actually providing food to consumers.” *Id.*

Applicant also argues that FASTING BAR is at most suggestive because it does not convey “an *immediate* idea of the qualities or characteristics of Applicant’s goods.” *Id.* at 8 (emphasis in original). “Instead, consumers must take a mental pause and use thought, perception, and imagination to come to their own conclusion as to the nature of Applicant’s goods, which are ‘nutritionally balanced prepared meals for medical use and nutritional meal replacement snacks for medical use.’” *Id.* Applicant

argues that “the term ‘FAST’ has a multitude of different meanings,” listing 33 possible ones. *Id.* at 9. Applicant claims that

By selecting one definition from the 33 different listed definitions, the Examining Attorney demonstrated that not only does the term “FAST” have a wide variety of meanings, but that the Examining Attorney was forced to consider a variety of meanings for the term “FAST” or “FASTING” in order to develop their [sic] own proposed definition of the Mark. Thus, the Examining Attorney had to use their [sic] own thought, perception, and imagination to come to a conclusion as to the meaning of the Applicant’s Mark in connection with Applicant’s nutritionally balanced prepared meals for medical use and nutritional meal replacement snacks for medical use.

Id. at 10.

Applicant similarly argues that there are multiple meanings of the word BAR, *id.* at 10-11, and that the Examining Attorney again “took it upon themselves [sic] to select one definition from the 14 possible different listed definitions.” *Id.* at 11. Applicant argues that the most well-known definitions are “used to describe a place that serves drinks and refreshment or in relation to the legal profession,” and that “[o]nly one of the supplied definitions supports the Examining Attorney’s assertion that the word ‘BAR’ as used in the Applicant’s mark means ‘an amount of food or another substance formed into a regular narrow block.’” *Id.* According to Applicant, as with the meaning of FASTING, “it is clear that the Applicant’s Mark required the Examining Attorney to take a mental pause, consider a variety of options, and then select one possible meaning out of the 14 different meanings of the term ‘BAR’ in order to formulate their [sic] proposed definition of the Mark and apply it to the Applicant’s goods.” *Id.*

Applicant next argues that “various articles provided by the Examining Attorney which describe fasting in connection with abstaining from food does [sic] not support the mere descriptiveness rejection, nor is it [sic] compelling.” *Id.* at 12. Applicant discusses each of the articles, stating as to each that it “fails to support the Examining Attorney’s proposed definition of the Mark and fails to show descriptive usage of the Mark in connection with Applicant’s Goods.” *Id.* at 12-14. Applicant argues that “none of the articles reference or discuss Applicant’s goods nor is Applicant’s Mark used in the articles.” *Id.* at 14.

Applicant concludes that

Applicant’s Mark is not intended to be used in connection with Applicant’s ProLon diet products, but rather is intended to be used as a stand-alone product for individuals to use as a quick snack or meal on the go. As such, none of the provided internet evidence is relevant to show descriptiveness of the Mark and therefore the Examining Attorney has not made a *prima facie* case to support a mere descriptiveness rejection.

Id. at 15.

2. The Examining Attorney

The Examining Attorney argues that “[t]he term ‘fasting’ means ‘to eat sparingly or abstain from some foods,’” 19 TTABVUE 4, and that “[w]ithin the relevant industry of dieting and/or food nutrition, this wording is commonly used to describe a particular type of diet known as fasting diets, or restricted calorie diets” *Id.* She cites multiple articles and webpages in the record that discuss intermittent fasting diets or fasting mimicking diets, *id.* at 4-6, and argues that “[t]his wording is

commonly used to describe the purpose or use of applicant's type of goods that are meant to be used as part of a fasting diet." *Id.* at 5. She further argues that

because the term FASTING is commonly used to refer to fasting, or restricted calorie diets and meal plans, it follows that the term "fasting" also describes a characteristic or use of the applicant's goods because the goods are meant to be used as part of a fasting, or restricted calorie, diet where the user eats sparingly and abstains from certain foods while eating applicant's identified goods.

Id. at 6.

She also claims that

a consumer seeing the term FASTING used in connection with applicant's meals and meal replacement snacks will recognize that the term "fasting" refers to a specific approach to dieting that is characterized by reducing one's caloric intake, or eating sparingly and abstaining from certain foods for certain amounts of time, and that the applicant's meals and meal replacement snacks are meant to be consumed as a part of that fasting diet as a means of reducing caloric intake.

Id. at 8.

The Examining Attorney argues that the "term 'bar' means 'An amount of food or another substance formed into a regular narrow block,'" *id.*, and that "[t]his wording is commonly used to refer to a type of food or snack eaten during a fasting diet, or restricted diet," *id.*, as shown by webpages in the record. She claims that "bars are a common food consumed during a fasting diet, either as a meal or as a snack. As a result, this term is highly descriptive, as applicant and third parties commonly use the term 'bar' to describe the shape and form of the goods, which renders the term non-source indicating." *Id.* at 9-10.

The Examining Attorney further argues that “the combination of the terms in the applied-for mark FASTING BAR does not transcend, obscure, or otherwise alter the merely descriptive commercial impression of each of the elements considered separately.” *Id.* at 11. She contends that “[i]n combination, the mark retains its merely descriptive meaning because it directly advises consumers that the goods include bars, or food in narrow block form, for consumption in a fasting, or restricted calorie diet where the user abstains from certain foods.” *Id.* at 12.

The Examining Attorney concludes that the “the most direct, reasonable, and therefore likely consumer impression of the applied-for mark FASTING BAR, in the context of the applicant’s goods, is that the prepared meals and meal replacement snacks include bars, or food in a narrow block form, that are specifically meant to be consumed during a fasting diet.” *Id.* at 13.

C. Analysis

As discussed above, we must first analyze the descriptiveness of the individual words FASTING and BAR in the proposed mark.

We begin with the word BAR. The Examining Attorney made of record a dictionary definition of “bar” as “[a]n amount of food or another substance formed into a regular narrow block (‘a bar of chocolate’),”²⁰ and Applicant’s counsel conceded in his rebuttal argument at the oral hearing that there was no dispute as to the meaning of BAR in the context of the involved goods. That was a wise concession because during prosecution Applicant responded to the Examining Attorney’s information

²⁰ December 10, 2018 Office Action at TSDR 49 (OXFORD LIVING DICTIONARIES).

request “Do the FASTING BAR goods include a bar of any kind?” by stating “Yes, some of the covered goods will come in bar or block form.”²¹ Applicant also pointed to its specimen of use “filed in support of the [Amendment to Allege Use] that was accepted [sic] FAST BAR, U.S. Trademark App. No. 87/635,643,”²² showing the food supplement in Applicant’s packaging:



There is no doubt that the word BAR merely describes a feature or attribute of at least the goods identified in the application as “nutritional meal replacement snacks

²¹ June 10, 2019 Response to Office Action at TSDR 6.

²² *Id.* at TSDR 3, 29-39. The goods identified in the FAST BAR application are “Nutritionally balanced prepared meals for medical use consisting primarily of grains, nuts and vegetables; nutritional meal replacement soups and snacks adapted for medical use; dietary supplements; food supplements; nutritional supplements; vitamin and mineral supplements; plant-based supplements containing algal oil, vegetable powders, and vitamins and minerals.” *Id.* at TSDR 27. The USPTO electronic records regarding the application made of record by Applicant indicate that the application was in suspension as of the filing of Applicant’s Amendment to Allege Use in April 2019, *id.*, and there is no evidence in the record that a registration of the mark has issued.

²³ In its pre-remand appeal brief, Applicant also acknowledged that “the word BAR might be apt to describe . . . ‘snacks.’” 7 TTABVUE 7.

adapted for medical use,” as the snacks will come in the form of a “regular narrow block” of food of the sort shown above.

The word FASTING in Applicant’s proposed mark is the gerund form of the verb “fast,” which means “to abstain from food” or “to eat sparingly or abstain from some foods.”²⁴ Applicant focuses on the first meaning in arguing that “fasting” means total abstention from food, 17 TTABVUE 7, and that “an individual cannot simultaneously fast and eat – it is one or the other.” *Id.* The record shows, however, that in the context of nutrition and dieting, “fasting” frequently involves “eat[ing] sparingly or abstain[ing] from certain foods,” rather than eating nothing at all. The record contains webpages discussing “Fasting Supplements,”²⁵ and “Different Types of Supplements to Take While Fasting,”²⁶ as well as multiple references to “intermittent fasting,” which may involve eating a normal diet on a certain number of days a week,

²⁴ December 10, 2018 Office Action at TSDR 4 (MERRIAM-WEBSTER DICTIONARY). As noted above, Applicant points to “a multitude of different meanings” of the word “fast.” 17 TTABVUE 9. Descriptiveness must be considered in relation to the goods for which registration is sought and the fact that a word may have a different meaning in a different context is not controlling. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018).

²⁵ *Id.* at TSDR 12-14.

²⁶ *Id.* at TSDR 16-17.

but consuming a reduced number of calories on the other days,²⁷ or “fasting mimicking diets,” which involve caloric restrictions for certain periods.²⁸

Applicant’s goods as identified could be used in both “intermittent fasting” diets and “fasting mimicking diets.” Applicant stated in response to the Examining Attorney’s information requests that it “researches, produces and provides nutrition related products and services, specifically nutria-technologies and fasting mimicking diets (FMDs),”²⁹ and Applicant owns Registration No. 5487435 of the mark FASTING MIMICKING DIET (FASTING and DIET disclaimed) for “dietary supplements; nutritional supplement energy bars.”³⁰

Applicant also stated during prosecution that its “FASTING BAR products are contemplated to resemble its FAST BAR meal replacement products,”³¹ and Applicant analogized the contemplated FASTING BAR products to the FAST BAR products in its responses to each of the Examining Attorney information requests,

²⁷ *Id.* at TSDR 15-48; June 28, 2019 Final Office Action at TSDR 6-25; June 11, 2020 Final Office Action at TSDR 29-45, 48, 53-65. One website describes various forms of “intermittent fasting,” including “5:2,” in which a person “takes in 500 calories for two non-consecutive days, eating normally over the rest of the week, maybe adding some intermittent fasting supplements.” December 10, 2018 Office Action at TSDR 18. Another website describes the “5:2” diet as “currently the most popular intermittent fasting diet,” *id.* at TSDR 32, and states that “[i]t’s called the 5:2 diet because five days of the week are normal eating days, while the other two restrict calories to 500-600 per day.” *Id.* Another website discusses “How to Eat on Fasting Days” and the options of “Three small meals” or “Two slightly bigger meals.” *Id.* at TSDR 36. Another website states that “It’s called a fasting diet, but it doesn’t mean you starve yourself for two days.” June 28, 2019 Final Office Action at TSDR 13.

²⁸ December 10, 2018 Office Action at TSDR 57-75; June 28, 2019 Final Office Action at TSDR 26-33.

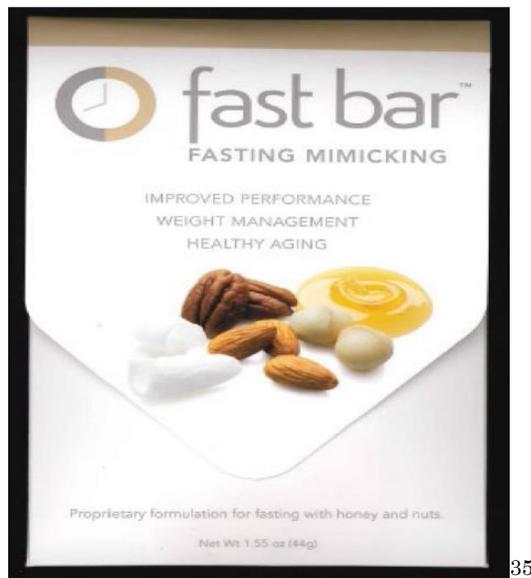
²⁹ June 10, 2019 Response to Office Action at TSDR 2.

³⁰ *Id.* at TSDR 17-18.

³¹ *Id.* at TSDR 3.

stating that “[l]ike with the FAST BAR products, the FASTING BAR products can be eaten as a meal replacement, or as a healthy snack.”³²

Although Applicant’s responses to the Examining Attorney’s information requests stated that the FASTING BAR products were not used with a fasting period, or as part of a fasting diet or restricted calorie diet,³³ Applicant also stated during prosecution that “[t]he FASTING BAR products are contemplated to be part of the meal replacement category.”³⁴ Applicant’s specimen of its FAST BAR mark also sheds light both on the meaning of the word FASTING in the proposed mark, and the meaning of the proposed mark as a whole, because it makes references to both “intermittent fasting” and “fasting mimicking.” We reproduce below portions of what Applicant submitted as its specimen:



³² *Id.* at TSDR 5-6.

³³ *Id.*

³⁴ *Id.* at TSDR 2.

³⁵ *Id.* at TSDR 33.



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36 *Id.* at TSDR 34.

37 *Id.* at TSDR 35.



Fasting is not a new trend. It has been part of humanity for spiritual practice, medical purpose, or for weight loss benefit.

Fast Bar features a proprietary blend of carefully selected high quality and natural ingredients at the correct portions of macro and micronutrients to maintain the body in a fasting mimicking state. It is a gluten-free, non-GMO, and soy-free meal bar. Patients can eat this tasty, high good-fat, low-protein bar in place of any meal to support goals of overall health.

Fast Bar is validated by the science of ProLon[®], the only Fasting Mimicking Diet (FMD)[®], and originally developed by the scientists at The Longevity Institute at the University of Southern California (USC).

Fast Bar is offered in boxes of 5 and 10.



The nutrition label and ingredients are on the back cover of this brochure.

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What is Fast Bar™?

Fast Bar is the only nutrition bar that mimics fasting and nourishes the body to keep it from starving thanks to a proprietary blend developed by L-Nutra that combines mostly natural macro and micro nutrients that enhance a fasting state while increasing the fasting time.

With Fast Bar your patients are Fasting with Food™. It is safer for the body and may help reduce symptoms associated with no-food fasting such as headaches and/or gallstone formation.

Fast Bar is the only nutrition bar that has been tested (preclinically and clinically), patented (filed), and positioned specifically for fasting. It is designed to help support metabolic well-being.



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³⁸ *Id.* at TSDR 36.

³⁹ *Id.* at TSDR 37. Applicant’s application contains language that the identified goods are “for medical use.” This portion of the FAST BAR specimen refers to “your patients,” suggesting that the goods sold under that mark may be promoted to physicians. There is no evidence in the record, however, and Applicant does not argue, that the FASTING BAR goods must be purchased through, or on the recommendation of, a physician rather than directly from Applicant or in some other manner. In any event, we find that the language “for medical use” in the identification does not affect how the mark would be understood by consumers because

The specimen shows that Applicant's claim that "an individual cannot simultaneously fast and eat – it is one or the other," 17 TTABVUE 7, while perhaps literally true at any particular moment, does not establish that the word "fasting" means complete abstention from food during, or in connection with, a "fasting" period. The specimen states, among other things, that the Fast Bar involves a "[p]roprietary formulation for fasting with honey and nuts," is used for "Fasting Mimicking," and is a "fasting mimicking meal bar." The specimen encourages consumers to "[e]njoy one Fast Bar preferably as a meal breakfast, or for lunch, or dinner, to **remain in an extended fasting state with no hunger**," and states that the Fast Bar provides "**nourishment while fasting with food**."⁴⁰ It displays the phrase "Fasting With Food™" as Applicant's claimed trademark.⁴¹

The record also contains a review of Applicant's FAST BAR product.⁴² The review discusses intermittent fasting and describes the products as "nutrition snack bars designed to curb the appetite to make periods of intermittent fasting more manageable."⁴³ The review also states that the creators of the Fast Bar "claim that they are most effective when integrated into an intermittent fasting pattern,"⁴⁴ and describes Applicant as "a nutrition technology company that is focused on nutritional

"[w]e cannot assume that consumers of Applicant's goods will be aware that its identification is so restricted and the restriction is not controlling of public perception." *Dolce Vita Footwear*, 2021 USPQ2d 479, at *11.

⁴⁰ *Id.* at TSDR 35 (emphasis added).

⁴¹ *Id.* at TSDR 37.

⁴² June 11, 2020 Final Office Action at TSDR 15-28.

⁴³ *Id.* at TSDR 15-16.

⁴⁴ *Id.* at TSDR 18.

supplements to help with intermittent fasting.”⁴⁵ The review claims that “Fast Bars work by giving the body a small supply of fats and proteins to keep the metabolism busy **while fasting**.”⁴⁶

The record as a whole, including Applicant’s statements during prosecution and in connection with its FAST BAR product to which it analogized the contemplated FASTING BAR products, makes it clear that the word FASTING in Applicant’s proposed mark describes a feature or attribute of at least the goods identified in the application as “nutritional meal replacement snacks adapted for medical use,” namely, that they are bars to be consumed as “meal replacement snacks” while “eat[ing] sparingly or abstain[ing] from certain foods.”⁴⁷

We turn now to the issue of whether the whole of Applicant’s proposed mark is more than merely the sum of its descriptive parts, specifically, “whether the combination of the component words of Applicant’s mark ‘conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.’” *Fat Boys*, 118 USPQ2d at 1515-16 (quoting *Oppedahl & Larson*, 71 USPQ2d at 1372).

Applicant primary argument on that issue appears to be that “[a]ll of the Examining Attorney’s internet evidence fails to shows [sic] descriptive usage of the Mark in connection with the Applicant’s goods.” 17 TTABVUE 12.⁴⁸ Applicant

⁴⁵ *Id.* at TSDR 19.

⁴⁶ *Id.* at TSDR 21 (emphasis added).

⁴⁷ December 10, 2018 Office Action at TSDR 4 (MERRIAM-WEBSTER DICTIONARY).

⁴⁸ Applicant similarly argued in its pre-remand appeal brief that the Examining Attorney “did not locate any use of the mark FASTING BAR in commerce” because “the mark

discusses multiple specific webpages, *id.* at 12-14, and states that each “fails to shows [sic] descriptive usage of the mark in connection with the Applicant’s goods.” *Id.* at 12. Applicant concludes that “none of these articles reference or discuss Applicant’s goods nor is Applicant’s Mark used in the articles.” *Id.* at 14.

Applicant’s argument seems to be that if the record does not show descriptive use of its proposed mark FASTING BAR per se, the mark cannot ipso facto be descriptive. That is not the law. “[T]here is no requirement that the Examining Attorney prove that others have used the mark at issue or that they need to use it, although such proof would be highly relevant to an analysis under Section 2(e)(1).” *Fat Boys*, 118 USPQ2d at 1514. “The fact that Applicant may be the first or only user of a term does not render that term distinctive, if it otherwise meets the standard” for descriptiveness. *Id.*

Applicant also argues that FASTING BAR as a whole is suggestive because “consumers must take a mental pause and use thought, perception, and imagination to come to their own conclusion as to the nature of Applicant’s goods, which are ‘nutritionally balanced prepared meals for medical use and nutritional meal replacement snacks for medical use.’” 17 TTABVUE 8. Applicant cites *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 36 USPQ2d 1659 (1st Cir. 1995), and *In re Tennis in the Round, Inc.*, 199 USPQ 496 (TTAB 1978), for the proposition that “[i]t is well established that if a consumer must exercise imagination, thought, and

‘FASTING BAR’ is not used in commerce, either as Applicant’s common law mark, or by another to describe a consumable product,” 7 TTABVUE 8, and that “the mark FASTING BAR as a whole is a meaningless, newly coined expression that was coined by Applicant.” *Id.*

perception to reach a conclusion as to the nature of the goods or services the term indicates, the term is suggestive and not merely descriptive.” 17 TTABVUE 8. Applicant appears to argue that its proposed mark is suggestive, not merely descriptive, because consumers cannot determine “the nature of the goods . . . the [mark] indicates” from the mark itself. *Id.* Applicant again misapprehends the law.

In *Equine Techs.*, the First Circuit held that the district court had properly found that the registered mark EQUINE TECHNOLOGIES for hoof pads for horses was suggestive rather than descriptive because “[t]he mark itself does not convey information about plaintiff’s product or its intended consumers; rather, it requires imagination to connect the term ‘Equine Technologies’ to hoof care products, in general, and to the plaintiff’s product in particular.” *Equine Techs.*, 36 USPQ2d at 1662. We are not bound by this regional circuit court decision, and while we give it respectful consideration, we must reject its test for determining descriptiveness to the extent that it conflicts with our own precedent holding that “the question is not whether someone presented only with the mark could guess the goods and services listed in the identification. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *In re Fallon*, 2020 USPQ2d 11249, at *11 (TTAB 2020) (quoting *Mecca Grade Growers*, 125 USPQ2d at 1953).

Tennis in the Round is binding precedent, but Applicant’s quotation of the language from the case that “[O]ne cannot glean from the Marks themselves specifically what the services are,” 17 TTABVUE 8 (quoting *Tennis in the Round*, 199

USPQ at 497), is misleading at best. In *Tennis in the Round*, the Board reversed a refusal to register TENNIS IN THE ROUND in block letters, and in a composite word-and-design mark, for the service of providing tennis facilities in the form of courts and tennis ball machines and offering instruction in tennis, but it did not do so on the basis of the quoted language, which is not the Board's original words, but rather is lifted from the Board's summary of the applicant's arguments. *Tennis in the Round*, 199 USPQ at 497. The Board itself applied the rule that

The question of whether a particular term is merely descriptive within the meaning of Section 2(e)(1) of the Act must be determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is used, and the significance it is likely to have to the average purchaser as he encounters the goods or services in the marketplace.

Id. at 498. Applicant's argument that its proposed mark FASTING BAR is suggestive because consumers cannot determine the goods identified in its application from the face of the mark itself is meritless because it addresses the wrong inquiry.

We find here that “[t]he two component words of the mark combine in a manner and order that would be easily interpreted by persons familiar with the English language and the goods.” *Fat Boys*, 118 USPQ2d at 1516. FASTING BAR would immediately be understood to describe meal replacement snacks in bar form that are used in the course of eating sparingly or abstaining from some foods. We thus find, based on the record as a whole, that the Examining Attorney established a prima facie case that Applicant's proposed mark is merely descriptive of a feature or attribute of at least one of the goods identified in the application, and that Applicant

did not rebut that case. Applicant's mark is thus ineligible for registration on the Principal Register in the absence of a showing of acquired distinctiveness.

Decision: The refusal to register is affirmed.